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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,149	04/28/2005	Michael Herzog	HERZ3001/FJD	5257
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EXAMINER				
KOO, GARY J				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/500,149

Applicant(s)

HERZOG, MICHAEL

Examiner

GARY KOO

Art Unit

2168

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-28 and 30-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-28 and 30-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to papers filed 07/19/2010.
2. Claims 19-28 and 30-36 are pending.
3. Claims 19-28 and 30-36 are rejected.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 19-28 and 30-36 are rejected under 35 U.S.C. 102(b) as being anticipated by DeWolfe (US 20020032626 A1).

As per claim 19, DeWolfe teaches:

- ***19. A method for maintaining a production installation in the technology of automation and process control, having a plurality of field devices, which are partly, or completely, connected over a data bus with a control system, comprising the steps of:*** (DeWolfe, [0009], "The present invention relates to networked computer systems and methods for asset registration and for conducting business (e.g. across a network) regarding the assets.")
- ***electronically registering the field devices in a manufacturer database with a manufacturer-specific identification and manufacturer-specific information relevant for the maintaining of the production installation,*** (DeWolfe, [0012], "Ownership and other attributes of "objects," including digital objects may be captured in a single, inter-operable database or in multiple and distinct databases or both. A GAIR contains, among other data, data regarding the object, producer, the owner and other agencies or individuals with a stockholder's interest in the same.")
- ***whereby the manufacturer-specific information is only accessible to the manufacturer*** (DeWolfe, [0092], "The invention anticipates that given the critical

- need to have some records of ownership be public, and some private that various embodiments of GAIR would incorporate robust and state of the art security.")
- *and whereby the manufacturer-specific information contains information about spare-parts or information when the production of each of the field devices will end;* (DeWolfe, [0107], "These records would be used subsequently for purposes such as ... repair and replacement part identification and procurement")
 - *electronically registering the field devices in a customer database with a customer-specific identification and customer-specific information,* (DeWolfe, [0008], "The present invention provides a method and system for attributing ownership of an asset or property to an individual, groups of individuals or other entities, as well as maintaining an up-to-date status regarding relevant attributes of the asset. In one embodiment of the present invention, a single interoperable database would comprise all possible forms of ownership and other attributes regarding each asset. The database would be broadly available across computer networks, such as the Internet, and would provide for interfaces with commonly used computer applications, such as Internet Browsers. In this embodiment, the registry would allow for all forms of individuals or organizations to participate in the registry. This includes participation not only of owners, producers, sellers, financiers, and insurers, but also allows for participation of organizations that have an interest in asset ownership and other attributes, including law enforcement agencies, courts of law, legislative bodies, and regulatory agencies. The registry would provide for methods of conducting transactions that alter the state of ownership and other attributes of the asset. The system would also generate and incorporate documentation related to the above.")
 - *whereby the customer-specific information is only accessible to the customer;* (DeWolfe, [0092], "The invention anticipates that given the critical need to have some records of ownership be public, and some private that various embodiments of GAIR would incorporate robust and state of the art security.")
 - *and electronically querying the two databases on the basis of maintenance criteria,* (DeWolfe, [0107], "The vehicle asset record includes all pertinent

information including but not limited records on sub-components, assembly and other manufacturing details, warranties, specifications, parts, owners manuals, maintenance and service schedules, and much if not all of the supply chain management and logistics of assembly.")

- *whereby the query determines the optimal stock of the spare parts or consumable materials inventory for the chosen maintenance strategy.* (DeWolfe, [0076], "In an example embodiment, the creation and use of a common, inter-operable source allows for efficiencies to be gained in every component part of the practices currently used.")

As per claim 20, the rejection of claim 19 is incorporated and further DeWolfe teaches:

- *20. The method as claimed in claim 19, wherein: the manufacturer-specific identification is the serial number of the field device.* (DeWolfe, [0045], "Typically assets are defined by a set of device dependent common characteristics, which include but are not limited to: ... serial number")

As per claim 21, the rejection of claim 19 is incorporated and further DeWolfe teaches:

- *21. The method as claimed in claim 19, wherein: the customer-specific identification is the tag number of the field device.* (DeWolfe, [0045], "Typically assets are defined by a set of device dependent common characteristics, which include but are not limited to: ... registration number")

As per claim 22, the rejection of claim 19 is incorporated and further DeWolfe teaches:

- *22. The method as claimed in claim 19, wherein: the maintenance criteria include corrective maintenance, replacement or preventive maintenance.* (DeWolfe, [0107], "The vehicle asset record includes all pertinent information including but not limited records on sub-components, assembly and other manufacturing

details, warranties, specifications, parts, owners manuals, maintenance and service schedules, and much if not all of the supply chain management and logistics of assembly.")

As per claim 23, the rejection of claim 19 is incorporated and further DeWolfe teaches:

- 23. *The method as claimed in claim 19, wherein: the database querying yields a maintenance plan.* (DeWolfe, [0107], "The vehicle asset record includes all pertinent information including but not limited records on sub-components, assembly and other manufacturing details, warranties, specifications, parts, owners manuals, maintenance and service schedules, and much if not all of the supply chain management and logistics of assembly.")

As per claim 24, the rejection of claim 23 is incorporated and further DeWolfe teaches:

- 24. *The method as claimed in claim 23, wherein: the maintenance plan is stored in a maintenance database and every separate point of the maintenance plan is confirmed or modified by the customer before the storing.* (DeWolfe, [0049], "Transactions 210 may be associated with documents 220 and vice versa. Documents 220 may include but are not limited to ... maintenance records")

As per claim 25, the rejection of claim 19 is incorporated and further DeWolfe teaches:

- 25. *The method as claimed in claim 19, wherein: the manufacturer database also includes foreign devices of other manufacturers.* (DeWolfe, [0040], "In a preferred embodiment, any individual or organization who entered data pertaining to an asset would always have access to that data. For example, a parts provider would always have access to their data (i.e., the assets the parts were in). For example, a tire manufacturer would have access to the GAIR 100 to identify all vehicles that their tires were installed on")

As per claim 26, the rejection of claim 25 is incorporated and further DeWolfe teaches:

- 26. *The method as claimed in claim 25, wherein: the manufacturer database (HG-DB), or portions thereof, come from Internet databases.* (DeWolfe, [0008], "The database would be broadly available across computer networks, such as the Internet")

As per claim 27, the rejection of claim 19 is incorporated and further DeWolfe teaches:

- 27. *The method as claimed in claim 19, wherein : the time required for the maintenance of the field devices is stored in said manufacturer database and from this information, combined with the maintenance plan, projected costs of maintenance work are calculated.* (DeWolfe, [0113], "Other manufacturers could use the GAIR to more accurately forecast failures and other expected costs (such as would be involved in recalls, warranty "actuarial" analyses, parts and service evaluations, etc.).")

As per claim 28, the rejection of claim 19 is incorporated and further DeWolfe teaches:

- 28. *The method as claimed in claim 19, wherein: already-experienced, actual expenses of the maintenance work for the field devices are stored in said customer database and a projected versus actual cost comparison is produced for the maintenance plan.* (DeWolfe, [0113], "Other manufacturers could use the GAIR to more accurately forecast failures and other expected costs (such as would be involved in recalls, warranty "actuarial" analyses, parts and service evaluations, etc.).")

As per claim 30, the rejection of claim 19 is incorporated and further DeWolfe teaches:

- 30. *The method as claimed in claim 19, wherein: the customer database is supplemented and modified by the operator itself of the production installation, via Internet access.* (DeWolfe, [0015], "In one embodiment, the asset registry would be broadly accessible across an electronic network. This would be accomplished, in part, through the use of generic or common software tools such as WWW browsers, Web Servers and Internet Transfer Protocols or other like computers and networks.")

As per claim 31, the rejection of claim 30 is incorporated and further DeWolfe teaches:

- 31. *The method as claimed in claim 30, wherein: the operator receives automatically and via Internet a maintenance plan adapted to a changed inventory of field devices or changed requirements for the maintenance strategy.* (DeWolfe, [0015], "In one embodiment, the asset registry would be broadly accessible across an electronic network. This would be accomplished, in part, through the use of generic or common software tools such as WWW browsers, Web Servers and Internet Transfer Protocols or other like computers and networks.")

As per claim 32, the rejection of claim 19 is incorporated and further DeWolfe teaches:

- 32. *The method as claimed in claim 19, wherein: device type managers (DTMs) are stored in said manufacturer database and are included in the maintenance plan in execution specifications intended for the maintenance personnel.* (DeWolfe, [0107], "The vehicle asset record includes all pertinent information including but not limited records on sub-components, assembly and other manufacturing details, warranties, specifications, parts, owners manuals, maintenance and service schedules, and much if not all of the supply chain management and logistics of assembly.")

As per claim 33, the rejection of claim 32 is incorporated and further DeWolfe teaches:

- 33. *The method as claimed in claim 32, wherein: electronic aids used for the maintenance are automatically adjusted by the maintenance plan.* (DeWolfe, [0107], "The vehicle asset record includes all pertinent information including but not limited records on sub-components, assembly and other manufacturing details, warranties, specifications, parts, owners manuals, maintenance and service schedules, and much if not all of the supply chain management and logistics of assembly.")

As per claim 34, the rejection of claim 19 is incorporated and further DeWolfe teaches:

- 34. *The method as claimed in claim 19, wherein: the maintenance plan represents the control file for asset management systems.* (DeWolfe, [0107], "The vehicle asset record includes all pertinent information including but not limited records on sub-components, assembly and other manufacturing details, warranties, specifications, parts, owners manuals, maintenance and service schedules, and much if not all of the supply chain management and logistics of assembly.")

As per claim 35, the rejection of claim 34 is incorporated and further DeWolfe teaches:

- 35. *The method as claimed in claim 34, wherein: control files for various asset management systems are produced by controlling the device type managers (DTMs).* (DeWolfe, [0107], "The vehicle asset record includes all pertinent information including but not limited records on sub-components, assembly and other manufacturing details, warranties, specifications, parts, owners manuals, maintenance and service schedules, and much if not all of the supply chain management and logistics of assembly.")

As per claim 36, the rejection of claim 19 is incorporated and further DeWolfe teaches:

- 36. *The method as claimed in claim 19, wherein: a plurality of manufacturers support manufacturer databases in the Internet and, for each device in an installation, the appropriate link to the corresponding Internet address of the manufacturer database is contained in the device type manager (DTM - e.g. FDT Tool) of the particular device.* (DeWolfe, [0008], "The database would be broadly available across computer networks, such as the Internet")

Response to Arguments

6. Applicant's arguments, see page 6, filed 07/19/2010, with respect to 35 USC 112 and objections to the specification have been fully considered and are persuasive. The 35 USC 112 rejections and objections to the specification have been withdrawn.

7. Applicant's arguments filed 07/19/2010 have been fully considered but they are not persuasive.

Argument:

For better defining the invention over the art, claim19 has been amended and claim 29 cancelled with its subject matter, basically included in claim 19. This amendment to claim 19 is believed to patentably distinguish over the art of record.

Response:

The examiner respectfully disagrees. The subject matter of claim 29 was previously rejected; and does not further define over the cited art. The new limitations are also taught by the cited reference.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GARY KOO whose telephone number is (571)270-3887. The examiner can normally be reached on Monday to Friday 9:30am to 6:00pm (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo can be reached on (571)272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gary Koo/
Examiner, Art Unit 2168

/Tim Vo/
Supervisory Patent Examiner, Art Unit 2168